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EXAMINER
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LEE, CYNTHIA K

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1795

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/628,316

Applicant(s)

O'HARA, JEANETTE E.

Examiner

Cynthia Lee

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24, 26-30, 32-45, 48 and 49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24, 26-30, 32-45, 48 and 49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Response to Arguments***

This Office Action is responsive to the amendment filed on 10/6/2006. Claims 1-24, 26-30, 32-45, 48 and 49 are pending.

Applicant's arguments have been fully considered and are not persuasive. Claims 1-24, 26-30, 32-45, and 49 are finally rejected for reasons stated herein below.

***Specification***

The disclosure is objected to because of the following:

Pg 6 of the Specification states that the controller may be configured such that the fuel cell operates at high relative humidity, moderate relative humidity, or low relative humidity.

The Examiner notes that a controller cannot supersaturate a reactant gas. A controller is a programmable device that may be connected to a supersaturating instrument, such as a humidifier, to control the relative humidity. It is unclear to the Examiner how supersaturation is achieved. For example, how does is the controller programmed to achieve supersaturation? What parameters or operating conditions are involved is achieving supersaturation?

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 49 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "wherein the carbonaceous porous fibrous matrix of the diffusion media substrate has a greater porosity than the mesoporous layer" is not supported by the disclosure as originally filed. Applicant relies on page 5 lines 24-26 for support for this limitation. However, it is noted that page 5 lines 24-26 supports that the mesoporous layer is more porous than the fibrous matrix, which is opposite to the claimed subject matter of claim 49.

Applicant is required to cancel the new matter in reply to this Office Action.

Claims 1-24, 26-35, 48, and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner notes that "a device configured to convert a hydrogenous fuel source to electrical energy" is interpreted to mean an electrical energy generating device, i.e. a fuel cell. Claim 1 recites that the "humidified reactant output exceeds about 150%" and claim 27 recites that "said humidified reactant output is

between about 100% and about 150%.” No guidance is given as to the disclosure as to how this is accomplished because a fuel cell generates electrical energy, not supersaturate reactant output gases. Further, it is unclear how a fuel cell can operate to yield supersaturated reactant output gas because it is an unstable state.

## su.per.sat.u.rate

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**verb** To cause (a chemical solution) to be more highly concentrated than is normally possible under given conditions of temperature and pressure.

**Other Derivatives:** su.per.sat.u.ra.tion, *noun*

*The American Heritage® Concise Dictionary, Third Edition, © 1994 by Houghton Mifflin Company* ❶

APA | MLA | Chicago : [Citing this entry](#)

supersaturate. The American Heritage® Concise Dictionary (1994). Retrieved 10 November 2006, from xreferplus. <http://www.xreferplus.com/entry/718872>

Also,

## supersaturation

The condition in which a solvent contains more dissolved matter (solute) than is present in a saturated solution of the same components at equivalent temperature. Such solutions may occur or can be made when a saturated solution cools gradually so that nucleating crystals do not form. They are extremely unstable and will precipitate upon addition of even one or two crystals of the solute or upon shaking or other slight agitation. Supersaturated solutions occur in the confectionery industry, e.g., in fudges, maple sugar, etc.

Moreover, the limitation in claim 23 "relative humidity of said humidified reactant output is about 300%" appears a bit high. If supersaturation of 300% is possible in a fuel cell, amount of direction and guidance are lacking in the disclosure.

Further, it is known in the art that supersaturation of the outlet gas is undesirable because water condenses to block the polymer membrane electrolyte pores to prevent the diffusion of reactant pores (see Enami US 5922485, 2:50-60). Thus, it is unclear to the Examiner how the Applicant's diffusion media functions with supersaturated outlet gases.

Hence undue experimentation would be required to determine how supersaturation is achieved and practiced and how the diffusion media functions properly in the applicant's invention as claimed.

With respect to enablement commensurate in scope with the claims, section 2164.08 of the MPEP states:

"The Federal Circuit has repeatedly held that 'the specification must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation'. In re Wright, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)... The determination of the propriety of a rejection based upon the scope of a claim relative to the scope of the enablement involves two stages of inquiry. The first is to determine how broad the claim is with respect to the disclosure. The entire claim must be considered. The second inquiry is to determine if one skilled in the art is enabled to

make and use the entire scope of the claimed invention without undue experimentation.”

Factors to be considered when determining whether the claimed invention would require undue experimentation are given in MPEP 2164.01 (a). In re Wands, 858 F. 2d 731, 737; 8 USPQ 2d 1400, 1404 (Fed. Cir. 1988). Only the relevant factors will be addressed for determining undue experimentation of the presently claimed invention. The relevant factors are (A) the breadth of the claims; (B) the amount of direction provided by the inventor; (C) the existence of working examples, and (D) the level of predictability in the art.

**Factor (A) Breadth of the claims:**

No guidance is given in the specification as to how a reactant output of an energy generating device is supersaturated because a fuel cell generates electrical energy, not supersaturate reactant output gases.

No guidance is given as to how the fuel cell membrane would be kept moist when the gas is supersaturated. No guidance is given as to how the reactant gases diffuse through the diffusion media when the supersaturated gas condenses to block the diffusion media pores.

**Factor (B) The amount of direction provided by the inventor.**

Applicant gives no guidance as to how supersaturation that exceeds 150% is achieved by the controller.

The specification (pg 6) further states that "Of course, in the event humidity regulation elements are employed in the fuel cell device downstream of the diffusion media and prior to the humidified reactant output, the relative humidity measures expressed herein are given as if such humidity regulation elements are not present in the device" (emphasis added). It is unclear how this is structurally accomplished within a fuel cell.

Further, it is unclear if supersaturation is a programming issue of a humidifier attached to a fuel cell, a programming issue of a fuel cell, or a functional configuration of the fuel cell. If it is a programming issue of the fuel cell or a functional configuration of the fuel cell, no guidance is given to guide one in the art how this is achieved.

**Factor (C) The existence of working examples:**

No working example is provided in the specification to guide one of ordinary skill in the art as to how to achieve supersaturation of the reactant outlet.

Thus, the claims are properly rejected for scope of enablement since the two stages of inquiry as set forth in MPEP section 2164.08 have been fully addressed herein by the Examiner.

The Examiner has considered the arguments of the Applicant but remain unpersuaded. Applicant asserts data that show output relative humidity values above



100% are possible for the presently claimed device. The Examiner notes that they are mere statements without addressing the factors raised by the Examiner above. The issue raised by the Examiner is that one of ordinary skill in the art would not be able to make and use the invention as presently claimed, and not the credibility of the invention.

It still does not address how supersaturation of 300% RH is achieved. The Applicants assert that the RH at the exit is readily calculated (using stoichiometry, pressure, etc). It is unclear to the Examiner as to what this means. What does etc. entail? How is relative humidity calculated? Is relative humidity claimed by the Applicants a theoretical calculation of input parameters and not a true relative humidity? Further, if RH of the exit stream is solely based on the inlet stream parameters, Applicants have not specified as to what input parameters are required to achieve 300% RH.

Moreover, the data provided in the Response is unclear to the Examiner. It is unclear as to what is meant by "Possible" cell averages, "Intermediate" values. Further, the data indicate that the RH<sub>exit</sub> is 3.068. It is unclear whether this value refers to the anode or the cathode gas. It is unclear to the Examiner how the data were obtained. Were they calculations of the input parameters, so as to obtain theoretical values?

Further, since supersaturation is unstable, at what point at the output stream is the 300% RH referring to? Applicants argues that when considering that the inlet streams were fully saturated to 100% RH, increasing the water content would necessarily raise the relative humidity of the exit stream to above 100% RH at the outlet (pg 9 of the arguments). The Examiner disagrees because the RH of the exit stream

would depend of the temperature. If the temperature of the fuel cell were higher than the temperature of the inlet stream, the RH of the exit stream would be below saturation.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-24, 26-35, 48, 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites that the "humidified reactant output exceeds about 150%" and claim 27 recites that "said humidified reactant output is between about 100% and about 150%." Claim 23 recites that the controller is configured such that a relative humidity of said humidified reactant output is about 300%".

It is unclear what the Applicant is claiming. The Examiner is interpreting "a device configured to convert a hydrogenous fuel source to electrical energy" to mean an electrical energy generating device, i.e. a fuel cell. As currently amended, the reactant outlet is humidified exceeding the relative humidity of 150%. It is unclear how an electrical energy generating device controls the relative humidity outputed by the reactant gas. Further, it is unclear how a fuel cell can operate to yield supersaturated reactant output gas because supersaturation is an unstable state.

It is further unclear what output the "humidified reactant output" refers to. Is it referring to a humidifying device or a fuel cell? If it is a fuel cell, is it the anode output gas or the cathode output gas?

Further, since the state of supersaturation is unstable, it is unclear to the Examiner as to what point downstream of the output the relative humidity of said humidified reactant output is measured.

The Examiner further notes that a controller cannot supersaturate a reactant gas. A controller is a programmable device that may be connected to a supersaturating instrument, such as a humidifier, to control the relative humidity. It is unclear to the Examiner how supersaturation is achieved. For example, how does the controller programmed to achieve supersaturation? What parameters or operating conditions are involved in achieving supersaturation?

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 9-11, 15, 17, 20-24, 27-30, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US 2003/0157397) in view of Andrews (US 6821660), as evidenced by Yoshida (US 2003/0091891).

Barton discloses a fuel cell comprising a cathode gas and an anode gas. The fuel cell comprises a gas diffusion backing layer on a catalyst coated membrane. The gas diffusion backing comprises a porous carbonaceous paper having randomly oriented fibrils (applicant's claim 15). The gas diffusion backing further comprises a microporous layer adjacent the porous carbonaceous paper. The microporous layer consists essentially of a fluorinated polymer that contains carbon particles [0050, 0055]. The carbon particles can comprise graphite fibers [0069]. The fluorinated polymer comprises poly(vinylidene fluoride) and PTFE [0060] (applicant's claim 9). Carbon particles can be of any form that include, but not limited to Vulcan ® XC72, SP Carbon & Ensaco, and Applied Science Graphite Fibers (applicant's claim 3) with an average surface area of about 50 to 800 m<sup>2</sup>/g [0069] (applicant's claims 1, 2, 5, 27, 28).

Although Barton discloses an average surface area of about 50 to 800 m<sup>2</sup>/g [0069] (applicant's claims 1, 2, 27, 28), Barton does not disclose that the surface area is below about 85 m<sup>2</sup>/g, between 60 m<sup>2</sup>/g and 80 m<sup>2</sup>/g, between 200 m<sup>2</sup>/g and 300 m<sup>2</sup>/g, or about 250 m<sup>2</sup>/g. Barton discloses that carbon particles are used to impart good electrical conductivity [0069]. Barton further discloses that the selection of the particular carbon particles (e.g., size and aspect ratio) will influence the level of porosity, coating thickness, and conductivity, as will be appreciated by those skilled in the art. In general, thinner coatings and larger pore sizes will promote mass transport across the coating. The formation of very large pores, however, tends to result in diminished contact between the carbon particles of the microporous layer and active regions of the catalyst, and thus reduces efficiency of a fuel cell for a given loading of carbon particles.

Namely, there will be a need to employ routine experimentation to optimize the microporous layer for a particular application. [0083]. The surface area is directly related to particle size and Barton clearly discloses that the particle size is a result effective variable. It has been held by the courts that discovering an optimum value or workable ranges of a result-effective variable involves only routine skill in the art, and thus not novel. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). See MPEP 2144.05. Further, it has been held by the courts that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Swain et. al.*, 33 CCPA 1250, 156 F.2d 239, 70 USPQ 412.

The microporous layer in the gas diffusion backing so formed has a thickness of about 1 to 100 microns, preferably between about 8 and about 16 microns (applicant's claims 10, 11, 30), and a coating weight of a fluorinated polymer of 0.1 to 20 mg/sqcm. In order to be useful in fuel cells, the layer so formed has a network of open micropores providing channels for the passage of water and reactant gases from one side to the other. Typically the micropores will constitute about 50% to about 85% of the layer, by volume, and have a mean pore size in the range of about 0.01 to about 5 microns [0082].

Barton discloses using Toray TGP-H-060. Toray TGP-H-060 has a bulk density of 0.46 g/ml, a gas permeability of 30 mm Aq/mm, and an average thickness of about 180 microns (applicant's claim 17, 42) [0096].

It is evidenced that the mean particle size of carbon Vulcan XC72 is about 30 nm, as evidenced by Yoshida [0131]. (applicant's claims 1, 27, 29).

Barton does not disclose that microporous layer infiltrates into the carbon paper to a depth of less than 10 um (claim 27). However, Barton discloses that the microporous layer will be coated or laminated directly onto the carbonaceous paper, and thus, be in electrically conductive contact [0055]. Further, since the carbon fibrous paper is porous, the microporous layer must necessarily microscopically infiltrate into the carbonaceous paper. Since Barton discloses that good electrical conductive contact must be present between the microporous layer and the carbon paper, it would have been obvious to one of ordinary skill in the art at the time the invention was made to vary and adjust the amount of infiltration for the benefit of attaining good adhesion between the two layers. The examiner notes that the disclosure provides no evidence of criticality with regard to 10 um of infiltration. Therefore, given Barton's teaching of the need for intimate contact between the microporous layer and the carbonaceous paper, one of ordinary skill in the art at the time the invention was made to vary and adjust the amount of infiltration for the benefit of attaining good adhesion between the two layers. Therefore, a limitation merely with respect to 10 um of infiltration will not support patentability unless such limitation is "critical".

Barton does not disclose the relative humidity of said humidified reactant product exceeds about 150% (claim 1 and 48) and 100% (claim 27) or a controller configured for a 150% relative humidity (claim 48). However, Andrews teaches humidification of the fuel gas and oxidant gas is generally required for fuel cells that use solid polymer

electrolyte membranes [0003]. Andrews teaches an apparatus for controlling the humidity of a gas stream such as a reactant gas stream and a fuel gas stream used in fuel cells. The specific water evaporation rate, gas delivery temperature, and the degree of gas humidity may be adjusted and maintained at predetermined levels [0023]. The amount of water vapor available for absorption by the gas stream can be varied up to the saturation point (applicant's relative humidity 100%) [0024]. As an alternate means of providing dew point control, the apparatus may further include a cooling heat exchanger to lower the temperature of the reactant gas, in effect approaching the desired dew point from an initial condition having a higher dew point. This temperature reduction will cause surplus water held by the reactant gas to condense, resulting in a lower dew point than the initial reactant gas. This apparatus controls the dew point of the reactant gas by first overheating and saturating the reactant gas and then providing a condensing surface at the desired dew point [0024].

The system also is equipped to determine when the system has exceeded the normal operation mode as a humidifier and has begun to operate in an undesirable boiler mode [0035]. The Examiner notes that since relative humidity above 100% is an unstable state, Andrew's apparatus achieves supersaturated state because when the apparatus makes a transition from a normal operating state to subnormal operating state, the reactant gas requires time to adjust to the subnormal state. At that instant, the reactant gas will be supersaturated before adjusting to the 100% saturation state of the subnormal state.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add Andrews' apparatus to Barton's fuel cell for the benefit of appropriately humidifying the fuel cell to prevent the polymer electrolyte membrane from drying as well as flooding. Applicant argued (pg 9 of Response) that "[w]hen considering that the inlet streams were fully saturated to 100% RH, increasing the water content would necessarily raise the relative humidity of the exit stream to about 100% RH at the outlet." Thus, the relative humidity of the output stream would necessarily be that of the relative humidity as claimed by the Applicants.

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Claims 14, 18, 19, 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US 2003/0157397) in view of Andrews (US 6821660), as evidenced by Yoshida (US 2003/0091891), as applied to claims 1 and 27, further evidenced by Cipollini (US 6379827).

Barton discloses all the elements of claims 1 and 27 and are incorporated herein. Barton does not disclose the porosity and the mean pore size of the carbon paper (applicant's diffusion media substrate). However, Barton discloses using Toray TGP-H-060. It is evidenced that Toray TGP-H-060 has porosity of about 65-75% (claim 32) and has a mean pore size of about 27 to 37 microns (applicant's claims 18, 19, 34), by Cipollini (5:30-45).



Further, since the pores in the microporous layer has porosity of about 50% to about 85% [Barton, 0082] and the carbon paper Toray TGP-H-060 has a porosity of about 65-75% (Cipolini, 5:30-45), limitation of claim 14 has been met.

Barton discloses using Toray TGP-H-060. Toray TGP-H-060 has a bulk density of 0.46 g/ml, a gas permeability of 30 mm Aq/mm, and an average thickness of about 180 microns (applicant's claim 33) [0096].

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Claims 7, 8, 12, 13, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US 2003/0157397) in view of Andrews (US 6821660), as evidenced by Yoshida (US 2003/0091891), as applied to claims 1 and 27 and incorporated herein.

Barton discloses all the elements of claims 1 and 27. Barton does not disclose that the microporous layer comprises greater than 80% of the carbon component. However, Barton discloses that the microporous layer comprises about 1 to 40 wt% carbon particles (applicant's carbon component), 1 to 20 wt% fluorinated polymer, and the balance being the dispersant or a solvent [0080]. Further, Barton discloses that typically, carbon particles are used to impart good electrical conductivity to the second layer (Barton's microporous layer) of the gas diffusion backing [0069]. It is clear that the amount of carbon particles affect the conductivity of the gas diffusion layer and thus, it would have been obvious to one of ordinary skill in the art at the time the invention was

made to vary the carbon particle amount (applicant's carbon component) proportionally to appropriately control the conductivity (applicant's claims 7, 8, 35). It has been held by the courts that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Swain et. al.*, 33 CCPA 1250, 156 F.2d 239, 70 USPQ 412. Further, Barton discloses that carbon particles affect conductivity, thus clearly teaching that the amount of carbon particles is a result effective variable. It has been held by the courts that discovering an optimum value or workable ranges of a result-effective variable involves only routine skill in the art, and thus not novel. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). See MPEP 2144.05.

Barton does not disclose that microporous layer infiltrates into the carbon paper to a depth of less than 5 um or 10 um. However, Barton discloses that the microporous layer will be coated or laminated directly onto the carbonaceous paper, and thus, be in electrically conductive contact [0055]. Further, since the carbon fibrous paper is porous, the microporous layer must necessarily microscopically infiltrate into the carbonaceous paper. Since Barton discloses that good electrical conductive contact must be present between the microporous layer and the carbon paper, it would have been obvious to one of ordinary skill in the art at the time the invention was made to vary and adjust the amount of infiltration for the benefit of attaining good adhesion between the two layers (applicant's claims 12, 13).

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Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US 2003/0157397) in view of Andrews (US 6821660), as evidenced by Yoshida (US 2003/0091891), as applied to claim 1 and incorporated herein, further in view of Larson (US 2003/0134178).

Barton discloses all the elements of claim 1. Barton discloses that the mean particle size of carbon Vulcan XC72 is about 30 nm, as evidenced by Yoshida [0131], but Barton does not disclose that the mean particle size is of about 42 (claim 4) nm. However, Larson teaches that carbon particles can be used for diffusion layer with typically having an average particle size of 1-100 nm [0027]. Larson teaches that the gas diffusion membrane must be conductive yet must be able to allow the passage of reactant and product fluids [0019]. Further, the particle size correlates with surface area, and thus the available reactive area. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the carbon particle size for the benefit of easily mixing the microporous layer mixture and ultimately adjusting the particle size to control the fluid passage and reactive surface area. It is clear that the mean particle size is a result effective variable. It has been held by the courts that discovering an optimum value or workable ranges of a result-effective variable involves only routine skill in the art, and thus not novel. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). See MPEP 2144.05.

The fluorinated polymer comprises poly(vinylidene fluoride) and PTFE [0060]. Carbon particles can be of any form that include, but not limited to Vulcan®, SP Carbon & Ensaco, and Applied Science Graphite Fibers. Although Barton does not expressly

disclose a hydrophilic carbonaceous component comprising acetylene black (applicant's claim 6), acetylene black is commonly used as a conducting agent in the fuel cell art, as shown by Larsen [0027]. It has been held by the court that the selection of a known material based on its suitability for its intended use is *prima facie* obvious. *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See MPEP 2144.07.

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Claims 16 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US 2003/0157397) in view of Andrews (US 6821660), as evidenced by Yoshida (US 2003/0091891) as applied to claim 15 and 48, further in view of Zuber (US 2002/0041992).

Barton discloses all the elements of claim 1 and are incorporated herein. Barton discloses that the porosity of the carbon paper is between 65-75%, as evidenced by Cipollini, but does not disclose that the porosity is above about 80%. However, Zuber teaches that the carbon substrate of the gas diffusion structure is preferably formed by a carbon fiber substrate with a porosity ranging between 60 and 90% [0022]. Further, Zuber teaches that the gas diffusion structure facilitates good access by the reaction gases to the electrodes and efficient conduction of the cell current are applied to the electrodes [0004]. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to increase the porosity of the diffusion substrate for the benefit of enhancing good diffusion of the reactant gases.

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Claims 36-40, 44, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US 2003/0157397), as evidenced by Yoshida (US 2003/0091891), in view of Larson (US 2003/0134178) and Andrews (US 6821660).

Barton discloses a fuel cell comprising a cathode gas and an anode gas. The fuel cell comprises a gas diffusion backing layer on a catalyst coated membrane. The gas diffusion backing comprises a porous carbonaceous paper having randomly oriented fibrils. The gas diffusion backing further comprises a microporous layer adjacent the porous carbonaceous paper. The microporous layer consists essentially of a fluorinated polymer that contains carbon particles [0050, 0055]. The carbon particles can comprise graphite fibers [0069]. The fluorinated polymer comprises poly(vinylidene fluoride) and PTFE [0060]. Carbon particles can be of any form that include, but not limited to Vulcan ® XC72, SP Carbon & Ensaco, and Applied Science Graphite Fibers with an average surface area of about 50 to 800 m<sup>2</sup>/g [0069].

Although Barton discloses an average surface area of about 50 to 800 m<sup>2</sup>/g [0069], Barton does not disclose that the surface area is above 750 m<sup>2</sup>/g (applicant's claim 36). Barton discloses that carbon particles are used to impart good electrical conductivity [0069]. Barton further discloses that the selection of the particular carbon particles (e.g., size and aspect ratio) will influence the level of porosity, coating thickness, and conductivity, as will be appreciated by those skilled in the art. In general, thinner coatings and larger pore sizes will promote mass transport across the coating.

The formation of very large pores, however, tends to result in diminished contact between the carbon particles of the microporous layer and active regions of the catalyst, and thus reduces efficiency of a fuel cell for a given loading of carbon particles. Namely, there will be a need to employ routine experimentation to optimize the microporous layer for a particular application. [0083]. The surface area is directly related to particle size and Barton clearly discloses that the particle size is a result effective variable. It has been held by the courts that discovering an optimum value or workable ranges of a result-effective variable involves only routine skill in the art, and thus not novel. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). See MPEP 2144.05. Further, it has been held by the courts that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Swain et. al.*, 33 CCPA 1250, 156 F.2d 239, 70 USPQ 412.

Barton discloses that the mean particle size of carbon Vulcan XC70 is about 30 nm, as evidenced by Yoshida [0131], but Barton does not disclose that the mean particle size is less than about 20 (claim 36). However, Larson teaches that carbon particles can be used for diffusion layer with typically having an average particle size of 1-100 nm [0027]. Larson teaches that the gas diffusion membrane must be conductive yet must be able to allow the passage of reactant and product fluids [0019]. Further, the particle size correlates with surface area, and thus reactive sites, as disclosed by Barton [0083]. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the carbon particle size for the benefit of easily mixing

the microporous layer mixture and ultimately adjusting the particle size to control fluid passage and the reactive surface area as appropriate. Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the particle size less than 20 nm for the benefit of tightly packing the carbon particles.

Barton does not disclose that the microporous layer comprises greater than 80% of the carbon component. However, Barton discloses that the microporous layer comprises about 1 to 40 wt% carbon particles (applicant's carbon component), 1 to 20 wt% fluorinated polymer, and the balance being the dispersant or a solvent [0080]. Further, Barton discloses that typically, carbon particles are used to impart good electrical conductivity to the second layer (Barton's microporous layer) of the gas diffusion backing [0069]. It is clear that the amount of carbon particles affect the conductivity of the gas diffusion layer and thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to vary the carbon particle amount (applicant's carbon component) proportionally to appropriately control the conductivity (applicant's claims 44, 45). It has been held by the courts that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. In re Swain et. al., 33 CCPA 1250, 156 F.2d 239, 70 USPQ 412.

Barton does not disclose that microporous layer infiltrates into the carbon paper to a depth of less than 5 um or 10 um. However, Barton discloses that the microporous layer will be coated or laminated directly onto the carbonaceous paper, and thus, be in electrically conductive contact [0055]. Further, since the carbon fibrous paper is porous,

the microporous layer must necessarily microscopically infiltrate into the carbonaceous paper. Since Barton discloses that good electrical conductive contact must be present between the microporous layer and the carbon paper, it would have been obvious to one of ordinary skill in the art at the time the invention was made to vary and adjust the amount of infiltration for the benefit of attaining good adhesion between the two layers (applicant's claims 39, 40).

The microporous layer in the gas diffusion backing so formed has a thickness of about 1 to 100 microns (applicant's claims 38), and a coating weight of a fluorinated polymer of 0.1 to 20 mg/sqcm. In order to be useful in fuel cells, the layer so formed has a network of open micropores providing channels for the passage of water and reactant gases from one side to the other. Typically the micropores will constitute about 50% to about 85% of the layer, by volume, and have a mean pore size in the range of about 0.01 to about 5 microns [0082].

Barton does not disclose a controller configured such that the relative humidity of said humidified reactant product is below about 100% (claim 36). However, Andrews teaches humidification of the fuel gas and oxidant gas is generally required for fuel cells that use solid polymer electrolyte membranes [0003]. Andrews teaches an apparatus for controlling the humidity of a gas stream such as a reactant gas stream and a fuel gas stream used in fuel cells. The specific water evaporation rate, gas delivery temperature, and the degree of gas humidity may be adjusted and maintained at predetermined levels [0023]. The amount of water vapor available for absorption by the gas steam can be varied up to the saturation point [0024]. The humidified reactant



gas stream is then maintained at a set point temperature that is at least above the dew point temperature of the humidified reactant gas. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add Andrews' apparatus to Barton's fuel cell for the benefit of appropriately humidifying the fuel cell to prevent the polymer electrolyte membrane from drying as well as flooding.

Claims 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US 2003/0157397) as evidenced by Yoshida (US 2003/0091891), in view of Larson (US 2003/0134178) and Andrews (US 6821660) as applied to claim 36, further evidenced by Cipollini (US 6379827).

Barton and Larson disclose all the elements of claim 36. Barton discloses using Toray TGP-H-060. It is evidenced that Toray TGP-H-060 has porosity of about 65-75% and has a mean pore size of about 27 to 37 microns (applicant's claims 41 and 43), by Cipollini (5:30-45). Toray TGP-H-060 has a bulk density of 0.46 g/ml, a gas permeability of 30 mm Aq/mm, and an average thickness of about 180 microns (applicant's claim 42) [Barton, 0096].

Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US 2003/0157397) in view of Andrews (US 6821660), as evidenced by Yoshida (US 2003/0091891) as applied to claim 27, further in view of Fuglevand (US 2004/0214057).

Barton modified by Andrews teaches all the elements of claim 27. Barton modified by Andrews does not teach that the carbonaceous porous fibrous matrix of the diffusion media substrate has a greater porosity than the mesoporous layer. However, Fuglevand teaches a gas diffusion layer comprising a macrodiffusion layer and a microdiffusion layer. The macrodiffusion layer comprises a carbon fiber based sheet having a porosity which is greater than the porosity of the microdiffusion layer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the diffusion media substrate with greater porosity than the mesoporous layer of Barton modified by Andrews, as taught by Fuglevand, for the benefit of limiting the water transport to the electrode by making the mesoporous layer with smaller porosity to prevent flooding.

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Claims 1-3, 5, 9-11, 15, 17, 20-24, 27-30, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US 2003/0157397) in view of Yoshimoto (US 6566002), as evidenced by Yoshida (US 2003/0091891).

Barton discloses a fuel cell comprising a cathode gas and an anode gas. The fuel cell comprises a gas diffusion backing layer on a catalyst coated membrane. The

gas diffusion backing comprises a porous carbonaceous paper having randomly oriented fibrils (applicant's claim 15). The gas diffusion backing further comprises a microporous layer adjacent the porous carbonaceous paper. The microporous layer consists essentially of a fluorinated polymer that contains carbon particles [0050, 0055]. The carbon particles can comprise graphite fibers [0069]. The fluorinated polymer comprises poly(vinylidene fluoride) and PTFE [0060] (applicant's claim 9). Carbon particles can be of any form that include, but not limited to Vulcan ® XC72, SP Carbon & Ensaco, and Applied Science Graphite Fibers (applicant's claim 3) with an average surface area of about 50 to 800 m<sup>2</sup>/g [0069] (applicant's claims 1, 2, 5, 27, 28).

Although Barton discloses an average surface area of about 50 to 800 m<sup>2</sup>/g [0069] (applicant's claims 1, 2, 27, 28), Barton does not disclose that the surface area is below about 85 m<sup>2</sup>/g, between 60 m<sup>2</sup>/g and 80 m<sup>2</sup>/g, between 200 m<sup>2</sup>/g and 300 m<sup>2</sup>/g, or about 250 m<sup>2</sup>/g. Barton discloses that carbon particles are used to impart good electrical conductivity [0069]. Barton further discloses that the selection of the particular carbon particles (e.g., size and aspect ratio) will influence the level of porosity, coating thickness, and conductivity, as will be appreciated by those skilled in the art. In general, thinner coatings and larger pore sizes will promote mass transport across the coating. The formation of very large pores, however, tends to result in diminished contact between the carbon particles of the microporous layer and active regions of the catalyst, and thus reduces efficiency of a fuel cell for a given loading of carbon particles. Namely, there will be a need to employ routine experimentation to optimize the microporous layer for a particular application. [0083]. The surface area is directly

related to particle size and Barton clearly discloses that the particle size is a result effective variable. It has been held by the courts that discovering an optimum value or workable ranges of a result-effective variable involves only routine skill in the art, and thus not novel. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). See MPEP 2144.05. Further, it has been held by the courts that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Swain et. al.*, 33 CCPA 1250, 156 F.2d 239, 70 USPQ 412.

The microporous layer in the gas diffusion backing so formed has a thickness of about 1 to 100 microns (applicant's claims 10, 11, 30), and a coating weight of a fluorinated polymer of 0.1 to 20 mg/sqcm. In order to be useful in fuel cells, the layer so formed has a network of open micropores providing channels for the passage of water and reactant gases from one side to the other. Typically the micropores will constitute about 50% to about 85% of the layer, by volume, and have a mean pore size in the range of about 0.01 to about 5 microns [0082].

Barton discloses using Toray TGP-H-060. Toray TGP-H-060 has a bulk density of 0.46 g/ml, a gas permeability of 30 mm Aq/mm, and an average thickness of about 180 microns (applicant's claims 17, 42) [0096].

It is evidenced that the mean particle size of carbon Vulcan XC72 is about 30 nm, as evidenced by Yoshida [0131]. (applicant's claims 1, 27, 29).

Barton does not disclose that microporous layer infiltrates into the carbon paper to a depth of less than 10 um (claim 27). However, Barton discloses that the

microporous layer will be coated or laminated directly onto the carbonaceous paper, and thus, be in electrically conductive contact [0055]. Further, since the carbon fibrous paper is porous, the microporous layer must necessarily microscopically infiltrate into the carbonaceous paper. Since Barton discloses that good electrical conductive contact must be present between the microporous layer and the carbon paper, it would have been obvious to one of ordinary skill in the art at the time the invention was made to vary and adjust the amount of infiltration for the benefit of attaining good adhesion between the two layers. The examiner notes that the disclosure provides no evidence of criticality with regard to 10 um of infiltration. Therefore, given Barton's teaching of the need for intimate contact between the microporous layer and the carbonaceous paper, one of ordinary skill in the art at the time the invention was made to vary and adjust the amount of infiltration for the benefit of attaining good adhesion between the two layers. Therefore, a limitation merely with respect to 10 um of infiltration will not support patentability unless such limitation is "critical".

Barton does not disclose the relative humidity of said humidified reactant product exceeds about 150% (claim 1 and 48) and 100% (claim 27). However, Yoshimoto teaches fuel cell in which the fuel inlet is a saturated humidified fuel gas (6:20-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to saturate the fuel inlet gas of Barton for the benefit of providing maximum moisture to the fuel cell to prevent the polyelectrolyte membrane from drying out. Applicant argued (pg 9 of Response) that "[w]hen considering that the inlet streams were fully saturated to 100% RH, increasing the water content would necessarily raise

the relative humidity of the exit stream to about 100% RH at the outlet." Thus, the relative humidity of the output stream would necessarily be that of the relative humidity as claimed by the Applicants.

Claims 14, 18, 19, 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US 2003/0157397) in view of Yoshimoto (US 6566002), as evidenced by Yoshida (US 2003/0091891), as applied to claims 1 and 27, further evidenced by Cipollini (US 6379827).

Barton discloses all the elements of claims 1 and 27 and are incorporated herein. Barton does not disclose the porosity and the mean pore size of the carbon paper (applicant's diffusion media substrate). However, Barton discloses using Toray TGP-H-060. It is evidenced that Toray TGP-H-060 has porosity of about 65-75% (claim 32) and has a mean pore size of about 27 to 37 microns (applicant's claims 18, 19, 34), by Cipollini (5:30-45).

Further, since the pores in the microporous layer has porosity of about 50% to about 85% [Barton, 0082] and the carbon paper Toray TGP-H-060 has a porosity of about 65-75% (Cipolini, 5:30-45), limitation of claim 14 has been met.

Barton discloses using Toray TGP-H-060. Toray TGP-H-060 has a bulk density of 0.46 g/ml, a gas permeability of 30 mm Aq/mm, and an average thickness of about 180 microns (applicant's claim 33) [0096].

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Claims 7, 8, 12, 13, 31, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US 2003/0157397) in view of Yoshimoto (US 6566002), as evidenced by Yoshida (US 2003/0091891), as applied to claims 1 and 27 and incorporated herein.

Barton modified by Yoshimoto teaches all the elements of claims 1 and 27. Barton does not disclose that the microporous layer comprises greater than 80% of the carbon component. However, Barton discloses that the microporous layer comprises about 1 to 40 wt% carbon particles (applicant's carbon component), 1 to 20 wt% fluorinated polymer, and the balance being the dispersant or a solvent [0080]. Further, Barton discloses that typically, carbon particles are used to impart good electrical conductivity to the second layer (Barton's microporous layer) of the gas diffusion backing [0069]. It is clear that the amount of carbon particles affect the conductivity of the gas diffusion layer and thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to vary the carbon particle amount (applicant's carbon component) proportionally to appropriately control the conductivity (applicant's claims 7, 8, 35). It has been held by the courts that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. In re Swain et. al., 33 CCPA 1250, 156 F.2d 239, 70 USPQ 412. Further, Barton discloses that carbon particles affect conductivity, thus clearly teaching that the amount of carbon particles is a result

effective variable. It has been held by the courts that discovering an optimum value or workable ranges of a result-effective variable involves only routine skill in the art, and thus not novel. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). See MPEP 2144.05.

Barton does not disclose that microporous layer infiltrates into the carbon paper to a depth of less than 5 um or 10 um. However, Barton discloses that the microporous layer will be coated or laminated directly onto the carbonaceous paper, and thus, be in electrically conductive contact [0055]. Further, since the carbon fibrous paper is porous, the microporous layer must necessarily microscopically infiltrate into the carbonaceous paper. Since Barton discloses that good electrical conductive contact must be present between the microporous layer and the carbon paper, it would have been obvious to one of ordinary skill in the art at the time the invention was made to vary and adjust the amount of infiltration for the benefit of attaining good adhesion between the two layers (applicant's claims 12, 13, 31).

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Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US 2003/0157397) in view of Yoshimoto (US 6566002), as evidenced by Yoshida (US 2003/0091891), as applied to claim 1 and incorporated herein, further in view of Larson (US 2003/0134178).

Barton modified by Yoshimoto teaches all the elements of claim 1. Barton discloses that the mean particle size of carbon Vulcan XC72 is about 30 nm, as



evidenced by Yoshida [0131], but Barton does not disclose that the mean particle size is of about 42 (claim 4) nm. However, Larson teaches that carbon particles can be used for diffusion layer with typically having an average particle size of 1-100 nm [0027]. Larson teaches that the gas diffusion membrane must be conductive yet must be able to allow the passage of reactant and product fluids [0019]. Further, the particle size correlates with surface area, and thus the available reactive area. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the carbon particle size for the benefit of easily mixing the microporous layer mixture and ultimately adjusting the particle size to control the fluid passage and reactive surface area. It is clear that the mean particle size is a result effective variable. It has been held by the courts that discovering an optimum value or workable ranges of a result-effective variable involves only routine skill in the art, and thus not novel. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). See MPEP 2144.05.

The fluorinated polymer comprises poly(vinylidene fluoride) and PTFE [0060]. Carbon particles can be of any form that include, but not limited to Vulcan®, SP Carbon & Ensaco, and Applied Science Graphite Fibers. Although Barton does not expressly disclose a hydrophilic carbonaceous component comprising acetylene black (applicant's claim 6), acetylene black is commonly used as a conducting agent in the fuel cell art, as shown by Larsen [0027]. It has been held by the court that the selection of a known material based on its suitability for its intended use is *prima facie* obvious. *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See MPEP 2144.07.

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Claims 16 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US 2003/0157397) in view of Yoshimoto (US 6566002), as evidenced by Yoshida (US 2003/0091891) as applied to claim 15 and 48, further in view of Zuber (US 2002/0041992).

Barton modified by Yoshimoto teaches all the elements of claim 1 and are incorporated herein. Barton discloses that the porosity of the carbon paper is between 65-75%, as evidenced by Cipollini, but does not disclose that the porosity is above about 80%. However, Zuber teaches that the carbon substrate of the gas diffusion structure is preferably formed by a carbon fiber substrate with a porosity ranging between 60 and 90% [0022]. Further, Zuber teaches that the gas diffusion structure facilitates good access by the reaction gases to the electrodes and efficient conduction of the cell current are applied to the electrodes [0004]. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to increase the porosity of the diffusion substrate for the benefit of enhancing good diffusion of the reactant gases.

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Claims 36-40, 44, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US 2003/0157397) as evidenced by Yoshida (US 2003/0091891), in view of Larson (US 2003/0134178) and Yoshimoto (US 6566002).

Barton discloses a fuel cell comprising a cathode gas and an anode gas. The fuel cell comprises a gas diffusion backing layer on a catalyst coated membrane. The gas diffusion backing comprises a porous carbonaceous paper having randomly oriented fibrils. The gas diffusion backing further comprises a microporous layer adjacent the porous carbonaceous paper. The microporous layer consists essentially of a fluorinated polymer that contains carbon particles [0050, 0055]. The carbon particles can comprise graphite fibers [0069]. The fluorinated polymer comprises poly(vinylidene fluoride) and PTFE [0060]. Carbon particles can be of any form that include, but not limited to Vulcan ® XC72, SP Carbon & Ensaco, and Applied Science Graphite Fibers with an average surface area of about 50 to 800 m<sup>2</sup>/g [0069].

Although Barton discloses an average surface area of about 50 to 800 m<sup>2</sup>/g [0069], Barton does not disclose that the surface area is above 750 m<sup>2</sup>/g (applicant's claim 36). Barton discloses that carbon particles are used to impart good electrical conductivity [0069]. Barton further discloses that the selection of the particular carbon particles (e.g., size and aspect ratio) will influence the level of porosity, coating thickness, and conductivity, as will be appreciated by those skilled in the art. In general, thinner coatings and larger pore sizes will promote mass transport across the coating. The formation of very large pores, however, tends to result in diminished contact between the carbon particles of the microporous layer and active regions of the catalyst, and thus reduces efficiency of a fuel cell for a given loading of carbon particles. Namely, there will be a need to employ routine experimentation to optimize the microporous layer for a particular application. [0083]. The surface area is directly

related to particle size and Barton clearly discloses that the particle size is a result effective variable. It has been held by the courts that discovering an optimum value or workable ranges of a result-effective variable involves only routine skill in the art, and thus not novel. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). See MPEP 2144.05. Further, it has been held by the courts that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Swain et. al.*, 33 CCPA 1250, 156 F.2d 239, 70 USPQ 412.

Barton discloses that the mean particle size of carbon Vulcan XC70 is about 30 nm, as evidenced by Yoshida [0131], but Barton does not disclose that the mean particle size is less than about 20 (claim 36). However, Larson teaches that carbon particles can be used for diffusion layer with typically having an average particle size of 1-100 nm [0027]. Larson teaches that the gas diffusion membrane must be conductive yet must be able to allow the passage of reactant and product fluids [0019]. Further, the particle size correlates with surface area, and thus reactive sites, as disclosed by Barton [0083]. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the carbon particle size for the benefit of easily mixing the microporous layer mixture and ultimately adjusting the particle size to control fluid passage and the reactive surface area as appropriate. Further, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the particle size less than 20 nm for the benefit of tightly packing the carbon particles.

Barton does not disclose that the microporous layer comprises greater than 80% of the carbon component. However, Barton discloses that the microporous layer comprises about 1 to 40 wt% carbon particles (applicant's carbon component), 1 to 20 wt% fluorinated polymer, and the balance being the dispersant or a solvent [0080]. Further, Barton discloses that typically, carbon particles are used to impart good electrical conductivity to the second layer (Barton's microporous layer) of the gas diffusion backing [0069]. It is clear that the amount of carbon particles affect the conductivity of the gas diffusion layer and thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to vary the carbon particle amount (applicant's carbon component) proportionally to appropriately control the conductivity (applicant's claims 44, 45). It has been held by the courts that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. In re Swain et. al., 33 CCPA 1250, 156 F.2d 239, 70 USPQ 412.

Barton does not disclose that microporous layer infiltrates into the carbon paper to a depth of less than 5 um or 10 um. However, Barton discloses that the microporous layer will be coated or laminated directly onto the carbonaceous paper, and thus, be in electrically conductive contact [0055]. Further, since the carbon fibrous paper is porous, the microporous layer must necessarily microscopically infiltrate into the carbonaceous paper. Since Barton discloses that good electrical conductive contact must be present between the microporous layer and the carbon paper, it would have been obvious to one of ordinary skill in the art at the time the invention was made to vary and adjust the

amount of infiltration for the benefit of attaining good adhesion between the two layers (applicant's claims 39, 40).

The microporous layer in the gas diffusion backing so formed has a thickness of about 1 to 100 microns (applicant's claims 38), and a coating weight of a fluorinated polymer of 0.1 to 20 mg/sqcm. In order to be useful in fuel cells, the layer so formed has a network of open micropores providing channels for the passage of water and reactant gases from one side to the other. Typically the micropores will constitute about 50% to about 85% of the layer, by volume, and have a mean pore size in the range of about 0.01 to about 5 microns [0082].

Barton does not disclose a controller configured such that the relative humidity of said humidified reactant product is below about 100% (claim 36). However, Yoshimoto teaches fuel cell in which the fuel inlet is a saturated humidified fuel gas (applicant's about below 100%) (6:20-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to saturate the fuel inlet gas of Barton for the benefit of providing maximum moisture to the fuel cell to prevent the polyelectrolyte membrane from drying out.

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Claims 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US 2003/0157397) in view of Yoshimoto (US 6566002), as evidenced by Yoshida (US 2003/0091891), further in view of Larson (US 2003/0134178) as applied to claim 36, further evidenced by Cipollini (US 6379827).

Barton modified by Yoshimoto and Larson teaches all the elements of claim 36. Barton discloses using Toray TGP-H-060. It is evidenced that Toray TGP-H-060 has porosity of about 65-75% and has a mean pore size of about 27 to 37 microns (applicant's claims 41 and 43), by Cipollini (5:30-45). Toray TGP-H-060 has a bulk density of 0.46 g/ml, a gas permeability of 30 mm Aq/mm, and an average thickness of about 180 microns (applicant's claim 42) [Barton, 0096].

Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US 2003/0157397) in view of Yoshimoto (US 6566002), as evidenced by Yoshida (US 2003/0091891) as applied to claim 27, further in view of Fuglevand (US 2004/0214057).

Barton modified by Yoshimoto teaches all the elements of claim 27. Barton modified by Andrews does not teach that the carbonaceous porous fibrous matrix of the diffusion media substrate has a greater porosity than the mesoporous layer. However, Fuglevand teaches a gas diffusion layer comprising a macrodiffusion layer and a microdiffusion layer. The macrodiffusion layer comprises a carbon fiber based sheet having a porosity which is greater than the porosity of the microdiffusion layer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the diffusion media substrate with greater porosity than the mesoporous layer of Barton modified by Yoshimoto, as taught by Fuglevand, for the benefit of limiting the water transport to the electrode by making the mesoporous layer with smaller porosity to prevent flooding.

***Response to Arguments***

Applicant's arguments filed 10/18/2007 have been fully considered but they are not persuasive.

Applicant's 35 USC 112, 1<sup>st</sup> paragraph arguments are not persuasive:

Contrary to Applicant's remarks, the Examiner notes that the nomenclature of the supersaturated relative humidity is not well-known in the art. Further, how the controller is used to regulate temperature, pressure, humidity, flowrates of the first and second reactant inputs and combinations thereof are not known in the art. Applicant is requested to provide evidence for this assertion.

The Declaration submitted on 10/18/2007 has been considered but is not persuasive. It is noted that the Declaration uses nomenclature as used by the Applicant, but does not define what is meant by supersaturated relative humidity. The Applicant explains in Remarks (pg 12) that supersaturated relative humidity means molar fraction of water at the output multiplied by total pressure divided by the total amount of water vapor pressure the gas can hold at that particular temperature. However, this definition is not supported by the Specification as originally filed, and thus cannot be used to define the Applicant's invention.

Thus, the Objection to the Specification is maintained.

The 112, 1<sup>st</sup> rejection is maintained.



Addressing Applicant's arguments to prior art Andrews:

Although Andrews teaches that the setpoint temperature of the reactant gas is set above the dew point temperature of the humidified reactant, the Examiner notes that as an alternate means of providing dew point control, the apparatus may further include a cooling heat exchanger to lower the temperature of the reactant gas, in effect approaching the desired dew point from an initial condition having a higher dew point. This temperature reduction will cause surplus water held by the reactant gas to condense, resulting in a lower dew point than the initial reactant gas. This apparatus controls the dew point of the reactant gas by first overheating and saturating the reactant gas and then providing a condensing surface at the desired dew point [0024]. This will cause the reactant gas to achieve saturation point but with a different dew point. Applicant argued (pg 9 of Response) that "[w]hen considering that the inlet streams were fully saturated to 100% RH, increasing the water content would necessarily raise the relative humidity of the exit stream to about 100% RH at the outlet." Thus, the relative humidity of the output stream would necessarily be that of the relative humidity as claimed by the Applicants.

Addressing Applicant's arguments on Yoshimoto

The Examiner notes that Yoshimoto is not relied upon for fully saturation of a fuel cell. The field of endeavor of Yoshimoto pertains to the similar field of endeavor as all the other prior arts, i.e. fuel cell, and thus the combination is proper.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Lee whose telephone number is 571-272-8699. The examiner can normally be reached on Monday-Friday 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Susy, Tsang-Foster can be reached on 571-272-1293. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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